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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,463	10/15/2001	William C. Johnson JR.	GEO-55	3692

7590 10/18/2006
Milton Wolson
11 Martine Avenue
12th Floor
White Plains, NY 10606

EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,463

Applicant(s)

JOHNSON, WILLIAM C.

Examiner

Jila M. Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 31, 2006 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 5, 6 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to claim 5 and 6, the limitation "in its uncompressed state" is an addition new matter. There appears to be no support for this limitation in the specification as originally filed. As seen on page 4, lines 18-24 specifically lines 22-24, "The thickness of cold weather insulation layer 20 may, for example, vary between .75 inches and 1.00 inches. It will be appreciated that the uncompressed cold insulating layer 20 provides superior cold weather insulation than

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does the compressed cold weather layer 4 of the prior art boot.” **This passage does not explicitly designate whether the insulation layer is measured in its compressed state or its uncompressed state.** Therefore, the assumption of the uncompressed state has no support. With respect to claim 12, the limitations that “a water-impermeable, water-vapor permeable membrane extending below the thinner layer of cold insulation material” has no support in the specification because the bootie 8 can be waterproof without being water-impermeable.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Techboot WO 92/14372 (WO '372) in view of White (US patent no. 3,805,419). WO'372 discloses all the limitations substantially as claimed including the following: a boot (see Figure 2); an outer layer 35 of stretchable leather (leather in and of itself is stretchable);

an oversized toe box 27 supported on the outsole (see Figures 1-4, shows the toe box resting on the outsole) and covered by the layer of stretchable leather 35; the toe box being sized to enclose a substantial thickness of compressible cold insulation material **(foam layer 43 and the amount of dead air space in the foam layer 43)** and the corresponding portion of the user's foot without compression of the cold insulating material when the boot is worn (see page 5, lines 1-10, the toe cap is spaced "relatively high of the foot at the rear " to allow for flexibility of the foot and prevent rubbing of the toe cap against the top of the user's foot); a layer of compressible cold insulating material in its uncompressed state (a layer of compressible cold insulating material 43 secured to the inside of the toe box in an uncompressed state); a lining 34 having a first side facing the opposing surface of a portion of a user's foot (lowermost side of the insulating material); the lining extending below the opposing surface of the cold insulating material (lining attached to the sole and not compressing the insulating layer to the protector); an outsole 10. WO '372 does not disclose the insulating material being located but not being compressed between the toe box and a lining of the cold insulating material having a surface secured to the underside of the toe box. White '419 teaches that an insulating layer 5 for a toe protected boot can be located, uncompressed, between the toe box 1 and the lining 6 to provide air absorption and cushioning to the user's foot during use. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to place an insulating layer between the toe box and the liner of WO '372, as taught by White '419, to aid in protecting and cushioning the user's foot while insulating the boot as well. White '419

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further discloses a toe cap 1 with a layer of cushioning material 5 attached to the under side of the toe cap by an adhesive 3 attaching the under side of the toe cap surface of the cushioning material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to attach the cushioning material to the toe cap by adhesive, as taught by White '419, to prevent the cushioning material from moving during flexing of the shoe during use.

With respect to claims 8 and 9, since the toe boxes of the references as applied above are intended to cover different size shoes, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to vary the size of the toe box to fit the size of the shoe being used, including a height of 1.9 inches and a length of 2 inches, so that the foot within the shoe is properly protected.

7. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 (WO '372) in view of White (US patent no. 3,805,419) as applied to claim 10 above, and further in view of Applicant's admission of obviousness. WO '372 in view of White '419 as applied above discloses all the limitations of the claims except for the thickness of the insulating material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the admitted prior art, to make the insulating material any thickness to insulate the boot to hold the desired temperature. The Official Notice was taken as admitted prior art since the applicant did not challenge it in the previous response.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 (WO '372) in view of White (US patent no. 3,805,419) as applied to claim 10

above, and further in view of Hill (US patent no. 2,814,888). The references as applied to claim 10 disclose all the limitations of the claims except for the thinner layer of cold insulating material extending below the second side of the lining. Hill '888 teaches that a pad 16 can be located under the lining and above another lining layer to add to cushioning of the toecap with respect to the user's toes. The pad would be another lining layer that would retard cold air from getting to the user's foot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to add as many layers on insulating material under the toe cap, of the references as applied to claim 10 above as taught by Hill '888, to give the desired comfort of the user.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 (WO '372) in view of White (US patent no. 3,805,419) and Hill (US patent no. 2,814,888) as applied to claims 10 and 11 above, and further in view of Aumann (US patent no. 5,689,903). The references as applied to claims 10 and 11 disclose all the limitations of the claims except for a layer of water-impermeable, water-vapor permeable membrane extending below the layer of cold insulating material. Aumann '903 teaches that it is desirable to have a layer of water-impermeable, water-vapor permeable material L (see col. 2, lines 32-37) located adjacent the user's foot in the toe area of the shoe to allow water vapor from the perspiration of the user's foot to escape without allowing water (i.e. waterproofing) to enter the shoe through the material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to place a water-impermeable, water-vapor permeable material next to the user's foot for the boot of the references as applied to claims 10 and 11

above, as taught by Aumann '903 to allow for the user's foot to breath without building up perspiration.

Response to Arguments

10. Applicant's arguments filed July 31, 2006 have been fully considered but they are not persuasive. Contrary to applicant's argument that the cold weather insulation material is not compressed, the cold weather insulation material of the instant application can get compressed once a wearer's toe is contacting and pressing on the waterproof bootie 8 and quilted layer 10.

11. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's arguments, see Remarks, filed July 31, 2006, with respect to thinner layer of cold insulating material of claim 11 have been fully considered and are persuasive. The rejection under 35 U.S.C. § 112, first paragraph of claim 11 has been withdrawn.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
October 16, 2006